

DETAILED ACTION

Examiner acknowledges receipt of 1/11/05 preliminary amendment to the specification and claims which was entered into the file. Claims (1-3, and 5-17) are currently pending.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 5, 7, 9-17, drawn to a coating process.

Group II, claim(s) 6 and 8, drawn to a coated metal article.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I and II are bound by a technical feature taught by John et al. (US patent 4,865,647, hereafter John, and provided by applicant in the IDS filed 1/11/05) in view of Daly (US patent 2,387,499; hereafter Daly). John teaches a method of making and applying an aqueous emulsion of linear modified polyisobutylene to a metal surface (see, for example, col 2 lines 40 – 65, col 4 lines 12 – 43, claims 1-20). Where the polyisobutylene polymer has a molecular weight of from 600 to 6000 (col 2 lines 40 – 65), and the polymer is fully functionalized (100%) (col 2 lines 3 – 65). John is silent as to how the polyisobutylene starting material is formed, so John does not explicitly teach using a BF_3 catalyst during preparation. Daly teaches that that it is well known to produce polyisobutylene by Friedel-Crafts polymerization and that for preparing simple polyisobutylene boron trifluoride is the preferable Friedel-Crafts catalyst (pg 2 col 1, lines 9 – 20). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated BF_3 as a catalyst in producing the

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polyisobutylene used in the method of John, as Daly has taught it as preferable. As John in view of Daly have taught the shared technical feature of Groups I and II, it is not a special technical feature and thus there exists a lack of unity of invention *a posteriori*.

SPECIES

3. If applicant elects "Group I", this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species belonging to the above "Group I" and are as follows:

A) The terminal polar groups is selected from those of claim 14

B) The terminal polar group is a succinic anhydride group

C) The terminal polar group is a phenoxyphosphoric acid group

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

Species A: Claim 14

Species B: Claims 15 and 16

Species C: Claim 17

The following claim(s) are generic: 1-3, 5, 7, 9-13.

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5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The species are independent or distinct as the disclosed species have mutually exclusive characteristics (each species' terminal polar group is differing and therefore non-overlapping).

6. A telephone call was made to Ashley Pezzner on 6/2/08 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN H. EMPIE whose telephone number is (571)270-1886. The examiner can normally be reached on M-F, 7:00- 4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571) 272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/N. H. E./
Examiner, Art Unit 1792

/Katherine A. Bareford/
Primary Examiner, Art Unit 1792